

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

TRANSLATION

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing (day/month/year) **See form PCT/ISA/210**

Applicant's or agent's file reference Rswk-02034		FOR FURTHER ACTION See paragraph 2 below	
International application No. PCT/EP2005/050134	International filing date (day/month/year) 13.01.2005	Priority date (day/month/year) 11.02.2004	
International Patent Classification (IPC) or both national classification and IPC A61K7/42, A61K7/48			
Applicant BEIERSDORF AG			

1. This opinion contains indications relating to the following items:

<input checked="" type="checkbox"/>	Box No. I	Basis of the opinion
<input checked="" type="checkbox"/>	Box No. II	Priority
<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/>	Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input checked="" type="checkbox"/>	Box No. VI	Certain documents cited
<input checked="" type="checkbox"/>	Box No. VII	Certain defects in the international application
<input type="checkbox"/>	Box No. VIII	Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered:

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP	Authorized officer
Facsimile No.	Telephone No.

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Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. II

Priority

1. ☐ The following document has not yet been furnished:

☐ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43bis.1 and 64.1) is the claimed priority date.

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	9	YES
	Claims	1-8, 10	NO
Inventive step (IS)	Claims		YES
	Claims	1-10	NO
Industrial applicability (IA)	Claims	1-10	YES
	Claims		NO

2. Citations and explanations:

- 1) This opinion mentions the following search report citations (documents D1-D15). The same numbering will be used throughout the procedure:

D1 = FR-A-2 801 211	D9 = WO-A-98/00098
D2 = EP-A-1 277 460	D10 = US-A-5,705,148
D3 = WO-A-02/096371	D11 = US-A-5,547,658
D4 = FR-A-2 819 408	D12 = US-A-2003/228268
D5 = FR-A-2 799 122	D13 = WO-A-03/101414
D6 = US-A-5,932,234	D14 = WO-A-03/070199
D7 = US-A-5,741,480	D15 = US-A-2003/129152
D8 = EP-A-0 424 282	

- 2) Independent claims 8 and 9 do not meet the requirements of PCT Article 6 because the subject matter for which protection is sought is not clearly defined. The description on page 4, paragraphs 3 and 4 reveals that the preparations comprise more than 5% by weight of glycerol. It is also stated that the preparations according to the present invention are characterized in that the skin shade achieved with them is more natural than that with comparable products with a lower glycerol content. This feature "more than 5% by weight of glycerol" is therefore essential for the definition of the invention. However, claims 8 and 9 do not contain this feature, and their scope therefore extends beyond the scope justified by the description.

Since the present independent claims 8 and 9 do not contain

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this feature, they do not meet the requirement of PCT Article 6 in conjunction with PCT Rule 6.3(b) that each independent claim must contain all of the technical features which are essential for the definition of the invention.

- 3) However, in preparing the present opinion with regard to novelty and inventive step, the wording of claims 8 and 9 as filed was taken into consideration.
- 4) The present application does not meet the requirements of PCT Article 33(1) because the subject matter of independent claims 1 and 8 is not novel within the meaning of PCT Article 33(2).

The example on page 9 of document D1 discloses a self-tanning preparation comprising 5% by weight of dihydroxyacetone (DHA) and 15% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.33. Examples 1.7, 2.1, 2.3, 2.5, 3.1, 3.3, 3.4, 4.1, 4.3, 4.4, 5.2 and 5.3 of document D2 disclose self-tanning preparations comprising DHA and glycerol in a weight ratio between 0.05 and 0.9. In addition, examples 2.2, 2.3, 2.5, 3.1, 3.3, 4.1, 4.3, 5.2 and 5.3 disclose self-tanning preparations comprising DHA and more than 5% by weight of glycerol.

Example 2 of document D3 discloses a self-tanning preparation comprising 4% by weight of DHA and 8% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.5.

Example 1 of document D4 discloses a self-tanning preparation in the form of an O/W emulsion comprising 5% by weight of DHA and 10% by weight of glycerol. This preparation comprises DHA and glycerol in a ratio weight of 0.5.

Example 1 of document D5 discloses a self-tanning preparation comprising 5% by weight of DHA and 10% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.5.

Example 2 of document D6 discloses a self-tanning preparation comprising 10% by weight of DHA and 11% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio

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of 0.91.

Composition 6 (example 3) in document D7 discloses a self-tanning preparation comprising 5% by weight of DHA and 30% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.16. Example 4 of document D8 discloses a self-tanning preparation comprising 4% by weight of DHA and 16.6% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.24.

Examples 2 and 10 of document D9 disclose self-tanning preparations comprising DHA and glycerol in a weight ratio between 0.05 and 0.9 (or 0.4 and 0.25). In addition, examples 2, 7, 10 and 12 disclose self-tanning preparations comprising DHA and more than 5% by weight of glycerol.

Example 2 of document D10 discloses a self-tanning preparation in the form of an O/W emulsion comprising 3% by weight of DHA and 20% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.15.

Example 2 of document D11 discloses a self-tanning preparation comprising 3% by weight of DHA and 10% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.3.

The example in table I of document D12 discloses a self-tanning preparation comprising 4% by weight of DHA and 5% by weight of glycerol. This preparation comprises DHA and glycerol in a weight ratio of 0.8.

Examples 4 and 11 of document D13 disclose self-tanning preparations in the form of an O/W cream comprising DHA and glycerol in a weight ratio between 0.05 and 0.9 (or 0.13 and 0.16). In addition, example 4 discloses a self-tanning preparation comprising DHA and more than 5% by weight of glycerol. Example 8 of document D14 discloses a self-tanning preparation in the form of an O/W microemulsion comprising DHA and glycerol in a weight ratio between 0.05 and 0.9 (or 0.1). In addition, example 11 discloses a self-tanning preparation in the form of an O/W microemulsion comprising DHA and more than 5% by weight of glycerol.

Example 1 of document D15 discloses a self-tanning preparation comprising 5% by weight of DHA and 10% by weight of glycerol.

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This preparation comprises DHA and glycerol in a weight ratio of 0.5.

- 5) The present application does not meet the requirements of PCT Article 33(1) because the subject matter of independent claim 10 is not novel within the meaning of PCT Article 33(2).

Documents D1, D9, D12 and D15 all describe the use of self-tanning preparations which comprise dihydroxyacetone and more than 5% by weight of glycerol for achieving a natural skin shade (see D1: page 1, lines 42 to 47; page 5, lines 34 to 37; see D9: page 1, lines 9 to 11; page 2, lines 4 to 7; see D12: page 1, paragraph [0005]; see D15: page 1, paragraphs [0005] and [0018]).

- 6) None of the documents cited in the international search report discloses the use of glycerol in self-tanning preparations which comprise DHA for achieving naturalness of the skin shade as is described in the present independent claim 9. It follows from this that the subject matter of the present claim 9 meets the requirements of PCT Article 33(2) with regard to the prior art which has been disclosed.

- 7) Dependent claims 2-7 do not contain any features which, in combination with the features of any claim to which they refer, meet the PCT requirements for novelty.

- 8) The subject matter of independent claims 8 and 9 does not meet the PCT requirements for inventive step (PCT Article 33(3)).

As already mentioned under point 2), the feature "more than 5% by weight of glycerol" is essential for the definition of the invention. However, claims 8 and 9 do not contain this feature, and therefore their scope extends beyond the scope justified by the description. For this reason, it is doubtful that the problem addressed was solved over the entire range of claims 8 or 9. The subject matter of the present claims 8 and 9 cannot therefore be considered inventive.

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- 9) Claims 1 to 10 meet the criterion specified in PCT Article 33(4) because the present invention is industrially applicable.

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Box No. VI Certain documents cited

1. Certain published documents (Rule 43bis.1 and 70.10)

Application No. Patent No.	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
EP-A-1 481 663	01.12.2004	27.05.2003	
EP-A-1 477 159	17.11.2004	10.04.2004	12.05.2003

See supplemental sheet

2. Non-written disclosures (Rule 43bis.1 and 70.9)

Kind of non-written disclosure	Date of non-written disclosure (day/month/year)	Date of written disclosure referring to non-written disclosure (day/month/year)
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See form 210

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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

- 1) Contrary to PCT Rule 5.1(a)(ii), the description does not cite documents D1 to D15 or indicate the relevant prior art disclosed therein.

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Box VI

Pursuant to PCT Rule 64.3, these documents do not form part of the prior art, but may become prior art pursuant to EPC Article 54(3) in the regional phase before the EPO.

Examples I to V of document EP-A-1 481 663 (D16) disclose self-tanning preparations comprising DHA and more than 5% by weight of glycerol. These preparations comprise DHA and glycerol in a weight ratio between 0.05 and 0.9.

Examples 1, 2, 4, 10-12, 14, 17, 20, 22, 25, 27, 30, 31 and 33 of document EP-A-1 477 159 (D17) disclose self-tanning preparations comprising DHA and glycerol in a weight ratio between 0.05 and 0.9. In addition, examples 1, 4, 10, 11, 20 and 30 disclose self-tanning preparations comprising DHA and more than 5% by weight of glycerol.

Consequently, documents D16 and D17 both deprive the present claims 1 to 8 and 10 of novelty.